

## REMARKS

The Office Action mailed Nov. 15, 2003 objected to the quality of the Figs. 1A, 9 and 10. Further, claim 1 (as well as claim 11) was rejected under Section 103(a) as unpatentable over Application Serial No. 20030011684 (Narayanaswami) and Application 20030063208 (Kazami). The Office Action noted as follows:

In regard to claims 1 and 11, Narayanaswami in paragraph [0032] details that his camera is capable of capturing an image or video. Narayanaswami further details that his invention can be used in portable computers or PDA devices (i.e. handheld computer). Narayanaswami in paragraph [0039] details that his invention has a touch panel for annotation of image data. Narayanaswami in paragraph [0038] details that his invention has an RF network for communicating with a remote computer.

Narayanaswami fails to explicitly state the use of a sketchpad connected to a handheld computer.

However, Kazami in paragraph [0076] details that that his camera has a touch tablet that is capable of drawing lines.

Therefor it would have been obvious to anyone of ordinary skill in the art at the time of the invention to combined Narayanaswami's camera capable of annotation of image information with Kazami's touch tablet in order to enable the user to specifically point out and annotate image data.

Applicants respectfully traverse the combination under Section 103(a).

Narayanaswami relates to an image capturing system and method for automatically watermarking a plurality of recorded camera and image parameters such as the location (latitude, longitude and altitude), orientation of the principal axis of the camera, whether the camera is in landscape mode or portrait mode, camera velocity, photographer information, time and date, zoom factor, shutter speed, flash on/off, autofocus distance, lightmeter reading, focal length and aperture into every captured image. This watermarked data can be subsequently extracted and compared with the originally recorded data so as to verify the authenticity of a corresponding image. The camera 100 preferably includes a radio frequency (RF) processor 112, operatively connected between

the CPU 102 and the RF port 116, for processing incoming RF, as well as transmitting RF information, via the RF port 116 using conventional constructions and techniques. A user interface/display 126, operatively connected to the camera electronics 128 and the CPU 102, is preferably a liquid crystal display (LCD) touch screen display (or equivalent user interface), for allowing a user to specify (i.e., choose) which of the plurality of parameters are to be recorded with the digital images (under the control of a suitable software program). The user interface/display 126 also is also utilized for displaying the "mode" of the camera 100 (i.e., the camera will keep track of which parameters should or should not be recorded at any given time). Alternatively, the interface/display 126 may be comprised of a keyboard and a conventional LCD display, which allows the user to further annotate each image with text descriptions (i.e., text parameters).

However, Narayanaswami fails to show a field inspection system comprising: a handheld computer to collect field construction data; a camera coupled to the computer to capture an image or video; a sketch pad coupled to the handheld computer to capture a sketch; and code to annotate the image and to communicate the image and field construction data to a remote computer.

Kazami is similarly devoid of such field construction data collection specifics. Since neither Narayanaswami nor Kazami shows the specifics of a field inspection system comprising: a handheld computer to collect field construction data; a camera coupled to the computer to capture an image or video; a sketch pad coupled to the handheld computer to capture a sketch; and code to annotate the image and to communicate the image and field construction data to a remote computer, neither can render claims 1 and 11 obvious. Withdrawal of the rejection is requested.

Claim 2-20 were rejected under 35 U.S.C. 103 (a) as being unpatentable over U. S. 2003/0011684 to Narayanaswami et al in view of U.S. 2003/0063208 to Kazami in view of U.S. 2002/0198755 to Birkner et al. The Office Action noted that "Narayanswami and Kazami fail to explicitly state a hand held computer that collects work in progress data. However, Birkner in paragraph [0189] details that his database has a daily work progress table (i.e. is capable of collecting daily work progress data. Therefore, it would have been obvious to anyone of ordinary skill in the art at the time of the invention to combined Narayanswami, and Kazami with Birkner to created a database with a portable terminal."

Applicants respectfully traverse the rejection. Birkner relates to a construction management system includes a handheld computer adapted to collect construction data from the field; a planning system to track budgetary information; a design system to perform site engineering assessment; and a construction system to track material consumption and progress for each project, the construction system adapted to receive data collected from the handheld computer, store daily project reports and generate key indicator reports.

However, Birkner does not show the specifics of a camera coupled to the computer to capture an image or video; a sketch pad coupled to the handheld computer to capture a sketch; and code to annotate the image and to communicate the image and field construction data to a remote computer.

Applicant notes that the present rejection does not establish *prima facie* obviousness under 35 U.S.C. § 103 and M.P.E.P. §§ 2142-2143. The Examiner bears the initial burden to establish and support *prima facie* obviousness. *In re Rinehart*, 189

U.S.P.Q. 143 (CCPA 1976). To establish *prima facie* obviousness, three basic criteria must be met. M.P.E.P. § 2142. First, the Examiner must show some suggestion or motivation, either in the Narayanaswami reference or in the knowledge generally available to one of ordinary skill in the art, to modify the reference so as to produce the claimed invention. M.P.E.P. § 2143.01; *In re Fine*, 5 U.S.P.Q.2d 1596 (Fed. Cir. 1988). Secondly, the Examiner must establish that there is a reasonable expectation of success for the modification. M.P.E.P. § 2142. Thirdly, the Examiner must establish that the prior art references teach or suggest all the claim limitations. M.P.E.P. §2143.03; *In re Royka*, 180 U.S.P.Q. 580 (CCPA 1974). The teachings, suggestions, and reasonable expectations of success must be found in the prior art, rather than in Applicant's disclosure. *In re Vaack*, 20 U.S.P.Q.2d 1438 (CAFC 1991). Applicant respectfully submits that a *prima facie* case of obviousness has not been met because the Examiner's rejection fails on all requirements. First, there is no suggestion or motivation in any of the cited art to combine to produce the claimed invention of a field inspection system comprising: a handheld computer to collect field construction data; a camera coupled to the computer to capture an image or video; a sketch pad coupled to the handheld computer to capture a sketch; and code to annotate the image and to communicate the image and field construction data to a remote computer.

Secondly, Applicant notes that no motivation or suggestion, either in the cited art reference or in the knowledge generally available to one of ordinary skill in the art, has been cited by the Examiner to modify the Narayanaswami reference so as to produce the claimed invention. As noted above, the Martinez et al. reference fails to teach or suggest producing successive digital data sets for the placement of brackets. Further, Applicant

fails to identify any motivation to modify the reference teaching so as provide a field inspection system comprising: a handheld computer to collect field construction data; a camera coupled to the computer to capture an image or video; a sketch pad coupled to the handheld computer to capture a sketch; and code to annotate the image and to communicate the image and field construction data to a remote computer as presently claimed.

Applicant points out that the Examiner bears the initial burden of factually establishing and supporting any *prima facie* conclusion of obviousness. *In re Rinehart*, 189 U.S.P.Q. 143 (CCPA 1976); M.P.E.P. § 2142. If the Examiner does not produce a *prima facie* case, the Applicant is under no obligation to submit evidence of nonobviousness. *Id.* In the instant case, the Examiner has not pointed to any evidence in Narayanaswami, or how knowledge of those skilled in the art, provide a suggestion or motivation to modify the reference teaching so as to produce the claimed invention of claim 1 and 11 for a field inspection system comprising: a handheld computer to collect field construction data; a camera coupled to the computer to capture an image or video; a sketch pad coupled to the handheld computer to capture a sketch; and code to annotate the image and to communicate the image and field construction data to a remote computer. See *In re Zurko*, 59 U.S.P.Q.2d 1693 (Fed. Cir. 2001) ([I]n a determination of patentability .... the Board cannot simply reach conclusions based on its understanding or experience - or on its assessment of what would be basic knowledge or common sense. Rather, the Board must point to some concrete evidence in the record in support of these findings).

Under *Vaeck*, absent any evidence of a cited suggestion or reasonable motivation in the Martinez et al. reference, or knowledge of those skilled in the art, for interpolating positional differences to produce successive digital data sets of tooth arrangements, *prima facie* obviousness of claims 1 and 11 (and those dependent therefrom) has not been established. As such, it is respectfully requested that the § 103(a) rejection of all claims be withdrawn and the claims be allowed.

As to the dependent claims, they are allowable as they depend from allowable claim 1. Withdrawal of the rejections of the dependent claims is requested.

In regard to claim 14, the Office Action noted:

Narayanswami and Kazami detail a hand held camera system capable of taking images and annotating images and communicating with a remote computer. For further details refer to examiner's notes for claim 1. Birkner in paragraph [0017] and figure 1 details that his invention is a construction project management system. Birkner in paragraph [0030] details that his invention deals with the construction phase (i.e. is capable of collecting construction data). Birkner further details that his invention is capable of tracking budgetary information using a planning system. Birkner in paragraph [0044] details that his invention is capable of producing reports from a field engineer (i.e. able to perform site-engineering assessment using a design system. Birkner in paragraph [0008] details that his database can track material consumption. Birkner in paragraph [0189] details that his database has a daily work progress table (i.e. track progress for each project).

Again, Applicants respectfully traverse the rejection as there was no suggestion or motivation, either in the Narayanaswami reference or in the knowledge generally available to one of ordinary skill in the art, to modify the reference so as to produce the claimed invention. M.P.E.P. § 2143.01; In re Fine, 5 U.S.P.Q.2d 1596 (Fed. Cir. 1988). Here, there is no suggestion or motivation to modify Narayanaswami to arrive at managing a construction project by collecting construction data from the field with a handheld computer; capturing an image of the construction project using a camera

coupled to the handheld computer; tracking budgetary information using a planning system; performing site engineering assessment using a design system; and tracking material consumption and progress for each project using a construction system, the construction system adapted to receive data collected from the handheld computer.

Secondly, the Examiner must establish that there is a reasonable expectation of success for the modification. M.P.E.P. § 2142. This was not done and the rejection should be withdrawn.

Thirdly, the Examiner must establish that the prior art references teach or suggest all the claim limitations. M.P.E.P. §2143.03; *In re Royka*, 180 U.S.P.Q. 580 (CCPA 1974). The teachings, suggestions, and reasonable expectations of success must be found in the prior art, rather than in Applicant's disclosure.

As discussed above, the references do not managing a construction project by collecting construction data from the field with a handheld computer; capturing an image of the construction project using a camera coupled to the handheld computer; tracking budgetary information using a planning system; performing site engineering assessment using a design system; and tracking material consumption and progress for each project using a construction system, the construction system adapted to receive data collected from the handheld computer.

In sum, claim 14 and those dependent therefrom are patentable over the cited references. Withdrawal of the rejection of all claims is requested.

CONCLUSION

Appellant believes that the above discussion is fully responsive to all grounds of rejection set for the in the Office Action.

Authorization to charge a small entity one month extension fee of \$55 to Deposit Account 501861 is granted.

If for any reasons the Examiner believes a telephone conference would in any way expedite resolution of the issues raised in this appeal, the Examiner is invited to telephone the undersigned at 408-528-7490.

Respectfully submitted,

By: 

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